

DETAILED ACTION

RCE: A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/11 has been entered.

Status of the claims: Claims 40, 41, 43, 44, 46-58 currently pending.

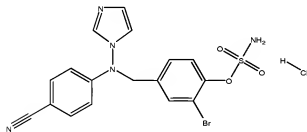
Priority: This application is a 371 of PCT/EP04/14847 (12/15/2004) and claims foreign priority to EUROPEAN PATENT OFFICE (EPO) 03 293 152.9 (12/15/2003) and EUROPEAN PATENT OFFICE (EPO) 04 292 681.6 (11/12/2004).

Election/Restrictions

1. Applicant previously elected Group I (claims 1-31 where Z is



Application also elected the following species (example 45):



, which reads on the instant claims when:

R1, R2, R4 = H,

R3 = CN,

R8/9 = -Br / -S(O₂)-NH₂

p=1

Q = CH₂.

As detailed in the following rejections, the generic claim encompassing the elected species was not found patentable. Therefore, the provisional election of species is given effect, the examination is restricted to the elected species only, and claims not reading on the elected species are held withdrawn.

Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection through amendment, the amended Markush-type claim will be reexamined to the extent necessary to determine patentability of the Markush-type claim. See MPEP 803.02.

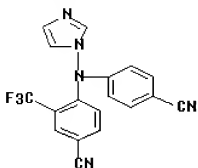
RESPONSE TO APPLICANT REMARKS

Claim Rejections - 35 USC § 102

2. Claims 40, 41, 43, 44, 46, 52-55 were rejected under 35 U.S.C. 102(e) as being anticipated by US 6737433. This rejection is amended to: Claims **40, 41, 43, 46-48, 52-55** are rejected under 35 U.S.C. 102(e) as being anticipated by US 6737433.

Applicant has amended the claims, however, the prior art continues to read on the claims as amended.

The '433 patent teaches the following compound

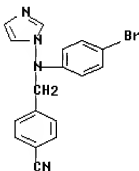


which anticipated the claims when:

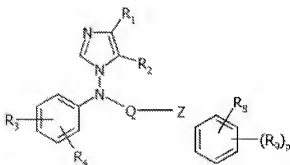
R₁, R₂, R₄ = H, R₃ = CN, R₈ = H, R₉ = -CN / -CF₃ p=2, Q = direct link

Applicant amended the claims to include a proviso to exclude where Q is a direct link.

However, the prior art also teaches species such as:



which reads on the claims as follows:



Q=CH₂; n=1; p=2; R₁ and R₂ are H;

R3=Br; R4=H; R8=CN; R9=H; R9=H

This rejection is **amended / maintained**.

NEW CLAIM REJECTIONS

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 40, 41, 43, 44, 46-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has added an extensive system of provisos to the claims:

- when p is 2, 3 or 4, each R₂ can be the same or different;
- when p=1, R₂ and R₃ together with the phenyl ring bearing them can also form a benzoxathiazine dioxide, a dihydrobenzoxathiazine dioxide, or a benzoxathiazole dioxide;

with the proviso that when Q is (CH₂)_n, n is 0, 1 or 2 and

1) when p is 1, then one of R₂ and R₃ is hydroxyl or a OSO₂NR₁₂R₁₃ group;

2) when p is 2, R₂ is cyano or (C₁-C₆) alkoxy and R₃ is hydrogen, then one R₂ is selected from the group consisting of hydroxy, cyano, halogen, nitro, (C₁-C₆) alkyl, (C₁-C₆) alkoxy, trifluoromethyl, acyl, NR₁₂R₁₃, OSO₂NR₁₂R₁₃, NR₁₂SO₂NR₁₂R₁₃, and CO₂R₁₂, and the other R₂ is selected from the group consisting of hydroxy, nitro, NR₁₂R₁₃, OSO₂NR₁₂R₁₃, NR₁₂SO₂NR₁₂R₁₃, and CO₂R₁₂;

3) when p is 3 or 4, then each R₂ is other than hydrogen

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. *In re Johnson*, 558 F.2d 1008, 1019, 195 USPQ 187, 196 (CCPA1977).

A claim containing a negative limitation which does not have a basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F. 2d 453 (Fed. Cir. 1984).

In this case, there is a series of selection criteria such as "when p is 2, R₃ is cyano ..., then one R₉ is ...," which does not have original support and one of skill in the art would not recognize that Applicant possessed such a tortuously defined scope.

Applicant has not pointed to support for the new negative limitations and the examiner could not locate support for such a new limitation.

Claim Objections

5. Claims 56-58 are objected to for being dependent on a rejected base claim.

Conclusion

The claims are not in condition for allowance.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 9:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/
Examiner, Art Unit 1626